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To: **Mail Stop Appeal Brief- Patents**
Examiner Krisanne Marie Jastrzab, GAU: 1744
Fax No.: (571) 273-8300
From: George M. Macdonald
Date: September 5, 2006
Subject: Serial No.: 10/036,991
Pages: 32 (including this cover)

Re: U.S. Patent Application Serial No.: 10/036,991
Confirmation No.: 5304
Our Docket # F-424

Enclosed please find Appellant's Amended Brief on Appeal in response to the August 4, 2006 Notice of Non-Compliant Appeal Brief.

CERTIFICATION OF FACSIMILE TRANSMISSION

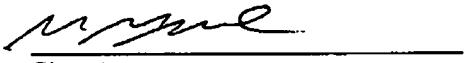
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1. Appellant's Amended Brief on Appeal (24 pages), including attached
2. Board Remand in U. S. Patent Application Serial No. 10/036,982 (7 pages).

on September 5, 2006

Date of Transmission


Signature

George M. Macdonald

Name of Registered Rep.

Reg. No.: 39,284

September 5, 2006

Date

Serial No.: 10/036,991
Attorney Docket No.: F-424

Patent

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re patent application of:

William E. Ryan, Jr., et al.

SEP 05 2006

Serial No.: 10/036,991

Examiner: Krisanne Marie Jastrzab

Filed: December 31, 2001

) Group Art Unit: 1744

Confirmation # 5304

}, *2000* *1*: 1–10.

Title: SYSTEM FOR SANITIZING INCOMING MAIL

Mail Stop Appeal Brief- Patents

Commissioner for Patents

Alexandria, VA 22313-1450

APPELLANTS' 2nd AMENDED BRIEF ON APPEAL

Sir:

This is an appeal pursuant to 35 U.S.C. § 134 and 37 C.F.R. §§ 41.31 et seq. from the final rejection of claims 1-15 of the above-identified application mailed April 1, 2005. This Amended Brief on Appeal is submitted in response to the August 4, 2006 Notice of Defective Appeal Brief. The Notice of Appeal was filed in this case on June 30, 2005. September 4, 2006 was a federal holiday. Accordingly, this Amended Brief is timely filed. No fee is believed due. The Commissioner is hereby authorized to charge any additional fees that may be required for this appeal or to make this brief timely or credit any overpayment to Deposit Account No. 16-1885. Enclosed with this original are two copies of this brief.

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September 5, 2006 (Date)

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I. Real Party in Interest

The real party in interest in this appeal is Pitney Bowes Inc., a Delaware corporation, the assignee of this application.

II. Related Appeals and Interferences

United States Patent Application Serial No. 10/036,982 ('982 Application) entitled System for Detecting the Presence of Harmful Materials in an Incoming Mail Stream has been identified by Appellants as a Related Application in the Cross Reference to Related Application. The '982 Application was appealed to the Board. The Appeal was remanded and a patent has since issued on the application. While not styled a decision, the June 10, 2005 BPAI Remand in related application 10/036,982 is attached in the Related Proceedings Appendix.

The June 10, 2005 Remand directly addressed a claim term present in the instant case and instituted a new rejection based upon 35 U.S.C. 112.

III. Status of Claims

Claims 1-3 are in the case and under final rejection of the Examiner and stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent Application Publication No. US 2002/0124664 A1 by Call, et al. ("Call '664").

Claims 4-15 are under further final rejection of the Examiner and stand rejected under 35 U.S.C. § 103(a) as allegedly being rendered obvious by U.S. Patent Application Publication No. US 2002/0124664 A1 by Call, et al. ("Call '664") in view of U.S. Patent No. 6,191,424 to Sterling, et al. ("Sterling '424").

Appellants hereby appeal the rejection of claims 1-15.

IV. Status of Amendments

There are no amendments to the claims filed subsequently to the final rejection of April 1, 2005. Therefore, the claims set forth in Appendix A to this brief are those as set forth before the final rejection.

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V. Summary of Claimed Subject Matter

Appellants' invention relates to systems for sanitizing incoming mail. This invention overcomes the disadvantages of the prior art by providing a system for processing incoming mail which integrates sanitization with mailpiece processing so as to help deter delays in incoming mail delivery caused by the presence of life harming material and sanitize the mail so as to protect the intended recipients from harm. This in turn affords for less delays in mailpiece processing.

The following two independent claims are on appeal and 35 USC section 112, sixth paragraph has not been invoked in the currently pending claims. Following the recitation of the independent claims on appeal, Appellants set forth an illustrative concise description of illustrative embodiments of the application that may be useful in considering the claims on appeal. Appellants refer to the specification by page and line number as well as references to reproduced Figures 5a, 5b, 5c and 6 along with the associated textual description and the cited reference numerals. Certain sections of the concise description have been underlined for emphasis. The independent claims on appeal:

1. A system for sanitizing mailpieces comprising:
a component for singulating and feeding a mailpiece along a feed path of the system;
a sanitizer module positioned downstream of the component for singulating and feeding the mailpiece, the sanitizer module for sanitizing the mailpiece;
a filtered transition area downstream of the sanitizer module; and
an output bin module for receiving a mailpiece after the mailpiece has been sanitized.

13. A system for sorting and sanitizing incoming mailpieces comprising:
a component for singulating and feeding a mailpiece along a feed path of the system;
a sanitizer module positioned downstream of the component for singulating and feeding the mailpiece, the sanitizer for decontaminating the mailpiece, the sanitizer module comprises:
a first set of guide walls, each guide wall in the first set of guide walls positioned parallel to the feed path and facing the other guide wall forming an alley along the feed path;

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a second set of guide walls positioned down stream of the first set of guide walls along the feed path and forming a gap along the feed path between the first set of guide walls and the second set of guide walls, each guide wall in the second set of guide walls positioned parallel to the feed path and facing the other guide wall forming an alley along the feed path;

a sanitization apparatus positioned along the feed path in the area of the gap along the feed path between the first set of guide walls and the second set of guide walls, the sanitization apparatus comprises at least one apparatus for the group consisting of: an irradiation apparatus, an ultraviolet light source, a microwave emitter, an ozone generator and a chemical mister;

an output bin module for receiving a mailpiece after the mailpiece has been sanitized

wherein at least a portion of the feed path comprises a transport belt which travels along an edge of the first set guide walls and an edge of the second set of guide walls; and

whereby the mailpiece is sanitized as it passes by the gap along the feed path between the first set of guide walls and the second set of guide walls, and wherein

the sanitizer module is adjacent to a filtered transition area.

As shown herein, illustrative embodiments of the application describe systems and methods for sanitizing incoming mail. Figures 5a, 5b, 5c and 6 are reproduced below for use in a summary discussion of an illustrative embodiment.

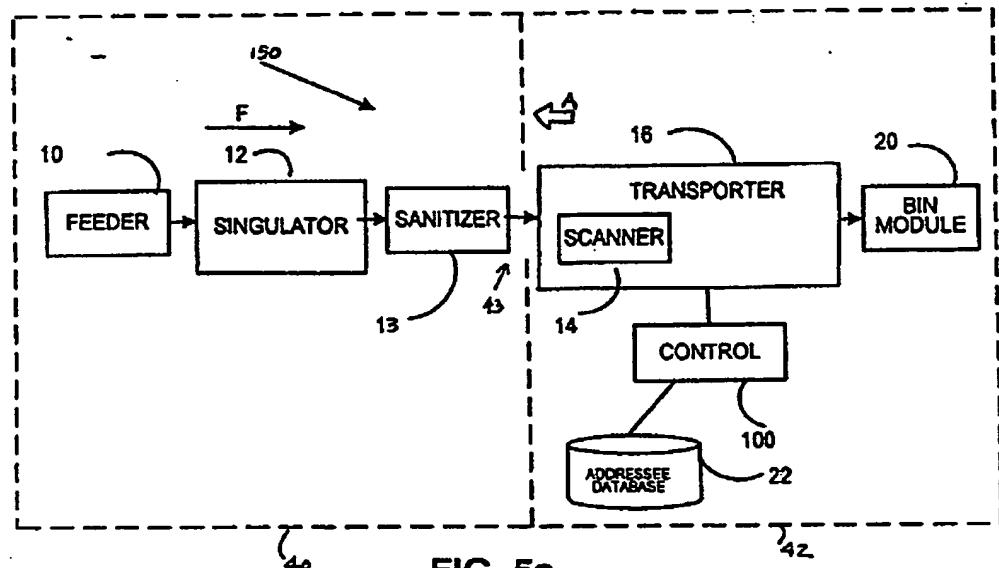


FIG. 5a

In the specification starting at page 11, paragraph 37 (line 4), through page 13, paragraph 42 (line 21), the embodiments of figures 5a-e are described. Figure 5a illustrates an embodiment of a system 150 of the present invention for sanitizing and sorting mailpieces. The system 150 of the present invention includes a feeder 10 for feeding mailpieces from a stack, a singulator 12 for separating mailpieces, a sanitizer 13 for sanitizing mailpieces 30 (sanitization can include for example killing biohazardous material in mailpieces 30 by means of microwave technology, irradiation, ultraviolet light, ozone, chemical mist or other technology that will kill the biohazardous material in the mailpiece without harming the letter/material content of the mailpiece). The system 150 further includes a transporter 16, a scanner 14 (such as a scanner for an optical character recognition (OCR) system), a control system 100 (such as the control system of Figure 1a), an addressee database 22 and a bin module 20 which is shown in further detail in Figure 5b to include individual sort bins 18. While eight sort bins 18 are shown in Figure 5b it should be understood that the number of sort bins 18 can be varied according to the needs of a sort plan used for determining the destination bin for each of the mailpieces 30 in the stack.

In another embodiment, shown with dashed lines, a sanitization room 40 can contain the feeder 10, singulator 12 and sanitizer 13 and a clean room 42 can include

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transporter 16, scanner 14, control 100 with database 22 and bin module 20. Other configurations for separating sections of the system 150 into sanitization area 40 and clean area 42 could be performed. The purpose of separating components of the system is to minimize exposure to and contain possible harmful elements that are emitted from or are in the mail stream. Operators stationed in the sanitization area 40 can be outfitted with personal protective equipment such as respirators, lab coats and protective clothing, eye and face protection and gloves. The clean room 42 is configured so that air flow between the clean room 42 and the sanitization area 40 is from the clean room 42 to the sanitization area 40 (thus the sanitization area has a negative pressure as compared to the clean room). The direction of air flow from clean room 42 to sanitization area 40 is shown by arrow A. Appropriate filtration and sealing can be provided in transition area 43 of the feed path F that is a passage between the clean room 42 and sanitization area 42. A containment module, for example, can be placed around that area with filtration devices and an opening along the feed path F to accommodate the largest mailpiece which can be sorted by the system. Operators of the sanitization room can be trained in appropriate safety practices including entrance and exit protocol, biohazard containment and proper attire.

Sanitizer 13, in addition to including sanitizing apparatus (shown generally as 13a and 13b with a sanitization area 44 denoted generally as a dashed line between modules 13a and 13b) described below can be configured in such a way as to transport singulated mailpieces past a sanitization area 44. This can be done for example using a configuration as shown in Figure 5c which includes a transport belt 45 for moving mailpieces and conveyor. In the sanitizer 13, the mailpieces 30 are driven along their bottom edges by a transport belt 45 along feed path F. The gap D between the guide walls 46a and 46b and 47a and 47b allows that the frictional forces between the mailpieces are almost nonexistent. Since the frictional forces tend to cause multi-mailpiece feeds, this configuration helps to prevent multi-mailpiece feeds from occurring. Furthermore, the sanitizing station acts as a buffer allowing mailpieces to deskew or register onto the transport belt 45. Subsequent to passage through the

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sanitizing station 13 the individual mailpieces are transported into the next segment of the system 150, the transport station 16.

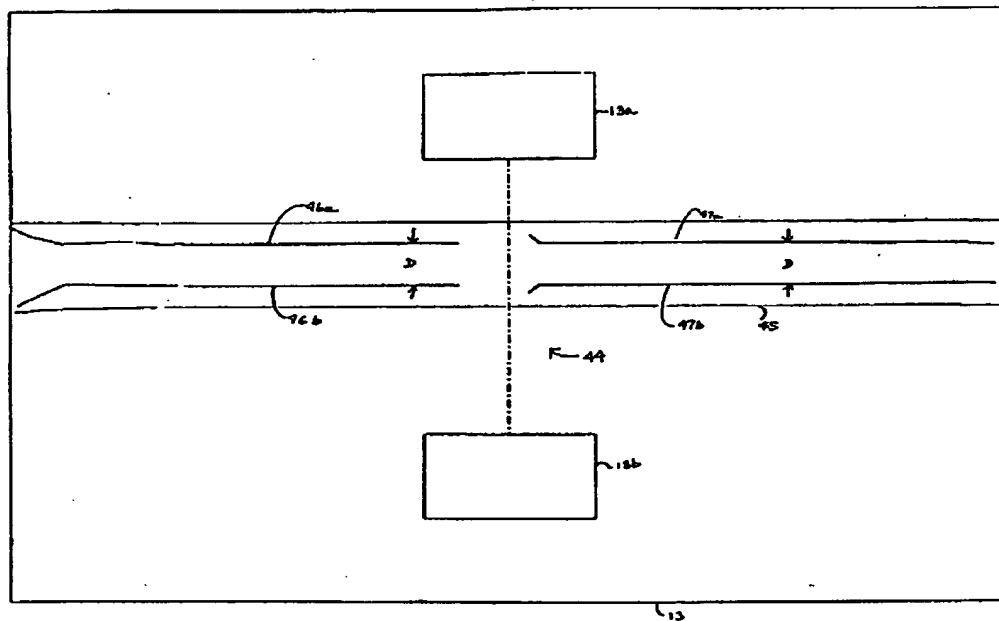


FIG. 5c

In the preferred embodiment, the distance D between guide walls 46a-b and 47a-b is approximately 28 millimeters. This allows for the passage of 3/4" thick mailpieces. However, other mailpiece thickness specifications and distances may be used. The minimum distance may be determined by the specification of the maximum width of mailpieces to be passed along the document feed path F. Additionally, the distance is determined by the minimum angle that the smallest mailpiece would have with respect to the transport belt 45 when leaning against guide walls 46a-b or 47a-b. The angle, if too small, would cause the mailpiece to lean below the sanitization area.

In an alternate embodiment (illustrated in Figure 5d), instead of guide walls, vertically oriented transport belts 48a-b and vertically oriented transport belts 49a-b are positioned parallel to and on each side of the transport belt 45 along feed path F. The vertically oriented belts are driven in the direction of the feed path F and serve to move the mailpieces along the feed path F as well as provide support for the mailpieces in a similar fashion to the guide walls 46a-b and 47a-b. An expanded view of a typical

configuration for vertically oriented transport belts 49a-b is shown in Figure 5e. A similar configuration may be used for vertically oriented transport belts 48a-b.

The sanitizer 13 for sanitizing mailpieces can include, for example, technology for killing biohazardous material such as Anthrax, contained in mailpieces 30 by means of microwave technology, irradiation, ultraviolet light, ozone, chemical mist or other technology that will kill the biohazardous material in the mailpiece without harming the letter/material content of the mailpiece).

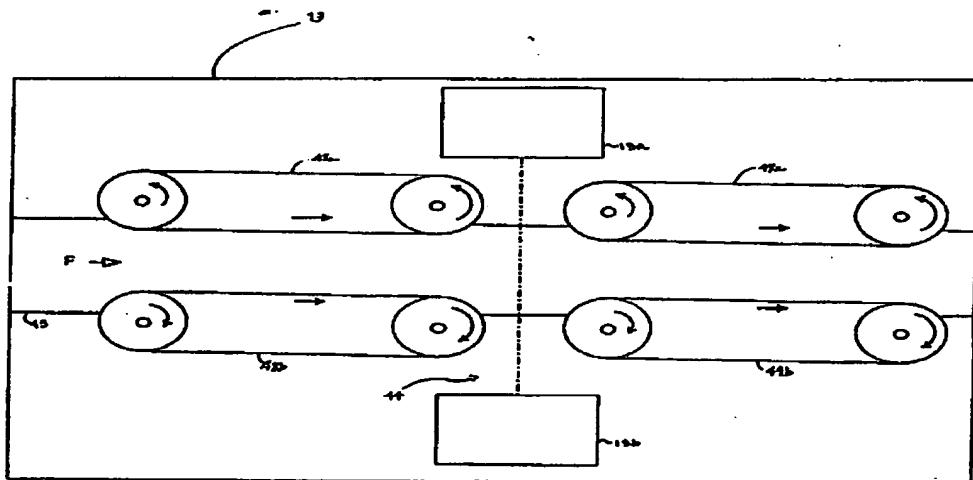


FIG. 5d

In the specification starting at page 13, paragraph 43 (line 22), through page 14, paragraph 45 (line 25), the embodiments of figure 6 is described. Figure 6 illustrates an embodiment of the system 151 of the present invention for sanitizing mail. The system 151 is a less costly system than that of system 150 since the system 151 does not include sortation components such as a sort plan, OCR system 14 and bin modules 20. The system 151 comprises a separation module 9 which includes feeder 10 and singulator 12. Down stream of separation module 9, along feed path F is sanitizer 13 followed by output module 17 for collecting the sanitized mailpieces 30. The sanitizer 13 for sanitizing mailpieces can include, for example, technology for killing biohazardous material such as Anthrax, contained in mailpieces 30 by means of microwave

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technology, irradiation, ultraviolet light, ozone, chemical mist or other technology that will kill the biohazardous material in the mailpiece without harming the letter/material content of the mailpiece). The output module 17 could be for example, a cart, a bucket, a stacker such as a horizontal or vertical stacker or other suitable component.

Alternately, the diverter and stacker modules can be integrated.

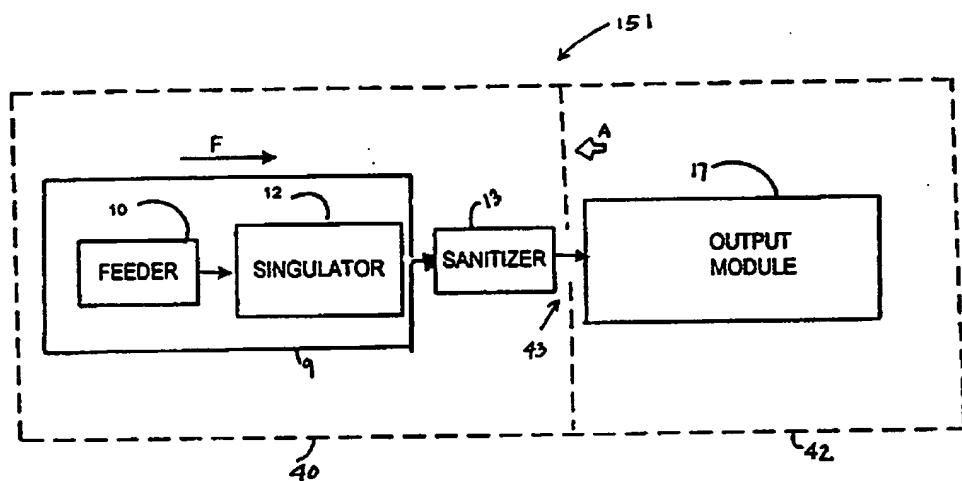


FIG. 6

In the present embodiment of the system of the present invention where mailpieces are moved along the feed path F in a vertical or on edge orientation, the output or collection module 17 could be an on-edge mail stacking system comprising a transport followed by various stacking mechanisms. Generally, a multi-bin on-edge stacking system includes gating mechanisms which divert specific mailpieces into predetermined stacker bins (not shown). Typically, mailpieces are transported vertically along a dual belt transport system, deflected into a stacker bin by a deflector mechanism, and guided into the bin by conventional guide and urging components. The objective of mail stacking systems is to produce one or more bundles of mailpieces.

In an alternate embodiment, shown with dashed lines, the sanitization room 40 can contain the separation module 9 (including feeder 10 and singulator 12) and sanitizer 13 and the clean room 42 can include output module 17. Other configurations for separating sections of the system 150 into sanitization area 40 and clean area 42 could be performed. The purpose of separating components of the system is to

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minimize exposure to and contain possible harmful elements that are emitted from or are in the mail stream. Clean room technology is explained generally above, note that in Figure 6 the direction of air flow is from clean room 42 to sanitization area 40 and is shown by arrow A.

Additional features of the invention are discussed below in the Argument section of this Brief. This summary is not intended to supplant the description of the claimed subject matter as provided in the claims as recited in Appendix A, as understood in light of the entire specification.

VI. Grounds of Rejection to Be Reviewed on Appeal

Whether claims 1-3 are patentable under 35 U.S.C. §102(e).

Whether claims 4-15 are patentable under 35 U.S.C. §103(a).

VII. Argument

As Appellants discuss in detail below, the final rejection of several of claims 1-15 is devoid of any factual or legal premise that supports the position of unpatentability. It is respectfully submitted that the rejection does not even meet the threshold burden of presenting a *prima facie* case of unpatentability. For this reason alone, Appellants are entitled to grant of a patent. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

A. Claims 1-3 are not Unpatentable under 35 U.S.C. § 102(e)

Claims 1-3 are in the case and under final rejection of the Examiner and stand rejected under 35 U.S.C. § 102(e) as allegedly being as allegedly being anticipated by U.S. Patent Application Publication No. US 2002/0124664 A1 by Call, et al. ("Call '664").

In the April 1, 2005 Final Office Action, the Examiner rejected claims 1-3 under 35 U.S.C. section 102(e). Appellants respectfully disagree with the rejection and urge its reversal for at least the reasons stated below.

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To establish anticipation of the claims under § 102(b), the Examiner is required to show that every element or step of the claim is found in a single reference. "To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter." PPG Indus., Inc. v. Guardian Indus. Corp., 75 F.3d 1558, 1566, 37 U.S.P.Q.2D (BNA) 1618, 1624 (Fed. Cir. 1996).

Initially, and most importantly, Appellants respectfully reiterate the submission that Call '664 is only available as prior art to the extent it is supported by the underlying provisional application. Accordingly, Appellants submit that references should be made to show subject matter support for the cited description of Call '664 in the related provisional application. Importantly, Appellants note that FIG.1 of Call 664 is not present in the underlying provisional application and that the paragraphs of Call '664 cited by the Examiner contain reference numerals in the 900 and above range that do not appear in the underlying provisional application. Accordingly, the rejection should be reversed.

Furthermore, as amended on January 6, 2005, Claim 1 recites:

1. A system for sanitizing mailpieces comprising:
a component for singulating and feeding a mailpiece along a feed path of the system;
a sanitizer module positioned downstream of the component for singulating and feeding the mailpiece, the sanitizer module for sanitizing the mailpiece;
a filtered transition area downstream of the sanitizer module; and
an output bin module for receiving a mailpiece after the mailpiece has been sanitized. (Emphasis added).

Call '664 does not teach or suggest a component for singulating mail pieces. It does not teach or fairly suggest a filtered transition area downstream of the sanitizer module and an output bin module for receiving a mailpiece after the mailpiece has been sanitized.

Appellants respectfully refer the Board refer to provisional application serial number 60/337,674.

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Accordingly, the Examiner has failed to establish a *prima facie* case for an anticipation rejection.

Dependent claims 2-3 includes similar elements and is patentable over the cited references for at least the same reasons.

For at least the above stated reasons, Appellants respectfully submit that the final rejection as to claims 1-3 is in error and should be reversed.

B. Claims 4-15 are not Unpatentable under 35 U.S.C. § 103(a)

Claims 4-15 are in the case and under further final rejection of the Examiner and stand rejected under 35 U.S.C. § 103(a) as allegedly being rendered obvious by U.S. Patent Application Publication No. US 2002/0124664 A1 by Call, et al. ("Call '664") in view of U.S. Patent No. 6,191,424 to Sterling, et al. ("Sterling '424").

In rejecting a claim under 35 U.S.C. §103, the Examiner is charged with the initial burden for providing a factual basis to support the obviousness conclusion. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967); *In re Lunsford*, 375 F.2d 385, 148 USPQ 721 (CCPA 1966); *In re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970). The Examiner is also required to explain how and why one having ordinary skill in the art would have been led to modify an applied reference and/or combine applied references to arrive at the claimed invention. *In re Ochiai*, 37 USPQ2d 1127 (Fed. Cir. 1995); *In re Deuel*, 51 F.3d 1552, 34 USPQ 1210 (Fed. Cir. 1995); *In re Fritch*, 972 F.2d 1260, 23 USPQ 1780 (Fed. Cir. 1992); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). In establishing the requisite motivation, it has been consistently held that both the suggestion and reasonable expectation of success must stem from the prior art itself, as a whole. *In re Ochiai*, *supra*; *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988).

Initially, Call '664 is not available as a reference for the reasons described above.

Claim 4 depends from claim 1 and recites:

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4. The system as claimed in claim 1 wherein the sanitizer module comprises:

a first set of guide walls, each guide wall in the first set of guide walls positioned parallel to the feed path and facing the other guide wall forming an alley along the feed path;

a second set of guide walls positioned downstream of the first set of guide walls along the feed path and forming a gap along the feed path between the first set of guide walls and the second set of guide walls, each guide wall in the second set of guide walls positioned parallel to the feed path and facing the other guide wall forming an alley along the feed path; and

a sanitization apparatus positioned along the feed path in the area of the gap along the feed path between the first set of guide walls and the second set of guide walls, wherein the sanitizer module is adjacent to the filtered transition area. (emphasis added).

In the April 1, 2005 Final Office Action, the Examiner rejected claims 4-15 under 35 U.S.C. section 103(a). Appellants respectfully disagree with the rejection and urge its reversal for at least the reasons stated below. Claims 4-12 are patentable for at least the reasons described above with reference to claim 1.

The Examiner cites to Call '664 to show a mailpiece decontamination system (not available as prior art as discussed above) and Stirling '424 to show a decontamination system having a conveyance. The Examiner does not address the structural limitations recited above that provide for advantageous mail handling and sanitization.

Regarding claims 5-12, significant additional recitation of elements as shown in Appendix A are not addressed.

Accordingly, the Examiner has failed to establish a *prima facie* case for an obviousness rejection.

With regard to claim 13 that recites:

13. A system for sorting and sanitizing incoming mailpieces comprising:

a component for singulating and feeding a mailpiece along a feed path of the system;

a sanitizer module positioned downstream of the component for singulating and feeding the mailpiece, the

sanitizer for decontaminating the mailpiece, the sanitizer module comprises:

a first set of guide walls, each guide wall in the first set of guide walls positioned parallel to the feed path and facing the other guide wall forming an alley along the feed path;

a second set of guide walls positioned down stream of the first set of guide walls along the feed path and forming a gap along the feed path between the first set of guide walls and the second set of guide walls, each guide wall in the second set of guide walls positioned parallel to the feed path and facing the other guide wall forming an alley along the feed path;

a sanitization apparatus positioned along the feed path in the area of the gap along the feed path between the first set of guide walls and the second set of guide walls, the sanitization apparatus comprises at least one apparatus for the group consisting of: an irradiation apparatus, an ultraviolet light source, a microwave emitter, an ozone generator and a chemical mister;

an output bin module for receiving a mailpiece after the mailpiece has been sanitized

wherein at least a portion of the feed path comprises a transport belt which travels along an edge of the first set guide walls and an edge of the second set of guide walls; and

whereby the mailpiece is sanitized as it passes by the gap along the feed path between the first set of guide walls and the second set of guide walls, and wherein

the sanitizer module is adjacent to a filtered transition area. (emphasis added).

The Examiner has not shown a reference or properly combined references teaching or suggesting at least the element emphasized above. Claims 14-15 is patentable over the cited references for at least the reasons discussed above.

Accordingly, the Examiner has failed to establish a *prima facie* case for an obviousness rejection.

For at least the above stated reasons, Appellants respectfully submit that the final rejection as to claims 4-15 is in error and should be reversed.

C. Arguments Made in Reply

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C.1 Call '664 is not available as a reference

The following arguments are offered here in the Amended Brief and were originally presented in the February 6, 2006 Reply Brief.

Regarding the 102(e) rejection as discussed below, Appellants disagree that Call '664 is available as art. Furthermore, regarding claim 1, Appellants respectfully submit that Call '664 is not available to teach a filtered transition area between the sanitizer and output bin as claimed.

Regarding the 103(a) rejection Appellants respectfully submit that the claimed structure is not taught in the cited references. With regard to claim 13, there is no teaching in the cited reference of a sanitizer module adjacent to a filtered transition area. With regard to claim 15 and as discussed more fully below, Call '664 is not available to teach an output module outside of the chamber as clearly claimed here:

a clean area, the clean area for containing the output module, the clean area connected to the sanitization area at a sanitization zone, the sanitization area having an area pressure lesser than an air pressure in the clean area.

As noted by the Examiner in the Answer, Appellants disagree that Call '664 is available as a reference unless supported by the underlying provisional. Additionally, Appellants submit that any subject matter in the provisional that is not published with the published application is also not available as prior art. Appellants noted in the opening brief that the Examiner cited to Fig. 1 and items numbered 900 that did not appear to be in the provisional. The Examiner states in the Answer: "this is not correct. Within the body of the rejection, the Examiner clearly points to column 2, paragraph 0020, column 7, paragraphs 0100, 0108 and 0109, column 8 and column 9, paragraph 0118 of Call '664." However, Appellants note that in Column 7, paragraph 108 and all of column 8 of Call '664 does indeed contain reference to Fig. 1 and many reference numerals in the 900 range. Appellants are not attempting to unduly cloud issues, but note that Fig. 1 of Call '664 differs significantly from Figs. 1-2 of the provisional including at which point in the line of equipment that filtration is placed. As taught in the present application, it can

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be advantageous to select certain portions of mail processing equipment for placement in the sanitizer room with others selected for placement in the post sanitizer clean room. For example, in the provisional, the outgoing mail handler is inside the containment chamber and in Call '664, Figure 1 does not include an outgoing mail handler. Appellant has searched Call '664 and finds the only reference to "output mail handler" in paragraph 127 that was not cited, but its location outside of the containment chamber as described in Fig. 1 of Call '664 is not supported in Fig. 1 of the underlying provisional.

The Examiner points to page 11, lines 5-28 and page 13 of the provisional and states that they "directly correspond" to the cited passages of Call '664. Appellants are not sure if that statement was intended to convey that they language is identical. The language in Call '664 is not identical. Of course, in some cases, a provisional using different language could support the subject matter of a particular printed publication. Here, the location of the outgoing mail handler has changed. Furthermore, the description of the incoming mail handler changes from arranging mail to separating mail.

Even if Call '664 was a proper reference, there is no motivation to combine it with Sterling '424 as there is no need in Call '664 for a decontamination gap. Furthermore, even Sterling '424 does not provide the structure missing from Call '664 as claimed.

C.2 The location of the filtered transition area

In the April 11, 2006 Supplemental Examiner's Answer, the Examiner states that the claim [claim 1] does not require that the filtered transition area be between the sanitization are and the output bin. Appellants respectfully disagree and submit that no reasonable claim interpretation would allow the construction that the Examiner is implying. Claim 1 recites the filtered transition area downstream of the sanitizer. The output bin has to be at the end of the "stream" of mail pieces because it is the output. The filtered transition area is downstream of the sanitizer and therefore in the stream. Since the output bin is at the end of the stream, the filtered transition area is in between

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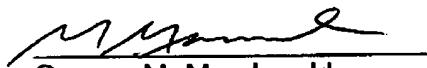
Patent

the sanitizer and the output bin as argued by Appellants. A review of FIG. 5A and FIG. 6 above leaves no room for any other interpretation. Call '664 is not supported in a description of such a system.

IX. Conclusion

In Conclusion, Appellants respectfully submit that the final rejection of claims 1-15 is in error for at least the reasons given above and should, therefore, be reversed.

Respectfully submitted,



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18/24 9/05/06 Appellants' Amended Appeal Brief

Serial No.: 10/036,991

Patent

Attorney Docket No.: F-424

VIII – CLAIMS APPENDIX
APPENDIX A

1. A system for sanitizing mailpieces comprising:
a component for singulating and feeding a mailpiece along a feed path of the system;
a sanitizer module positioned downstream of the component for singulating and feeding the mailpiece, the sanitizer module for sanitizing the mailpiece;
a filtered transition area downstream of the sanitizer module; and
an output bin module for receiving a mailpiece after the mailpiece has been sanitized.
2. The system as claimed in claim 1 whereby the mailpiece is sanitized as it passes through the sanitizer module.
3. The system as claimed in claim 1 whereby the output module comprises a bin, a cart, or a stacker.
4. The system as claimed in claim 1 wherein the sanitizer module comprises:
a first set of guide walls, each guide wall in the first set of guide walls positioned parallel to the feed path and facing the other guide wall forming an alley along the feed path;
a second set of guide walls positioned down stream of the first set of guide walls along the feed path and forming a gap along the feed path between the first set of guide walls and the second set of guide walls, each guide wall in the second set of guide walls positioned parallel to the feed path and facing the other guide wall forming an alley along the feed path; and
a sanitization apparatus positioned along the feed path in the area of the gap along the feed path between the first set of guide walls and the second set of guide walls, wherein the sanitizer module is adjacent to the filtered transition area.

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5. The system as claimed in claim 4 and whereby the mailpiece is sanitized as it passes by the gap along the feed path between the first set of guide walls and the second set of guide walls.

6. The system as claimed in claim 4 wherein the sanitization apparatus comprises at least one apparatus for the group consisting of: an irradiation apparatus, an ultraviolet light source, a microwave emitter, an ozone generator and a chemical mister.

7. The system as claimed in claim 4 wherein at least a portion of the feed path comprises a transport belt which travels along an edge of the first set guide walls and an edge of the second set of guide walls.

8. The system as claimed in claim 1 wherein the sanitizer module comprises:
a first set of first and second driven belts, each driven belt in the first set of driven belts positioned parallel to the feed path and facing the other driven belt and forming an alley along the feed path;

 a second set of first and second driven belts positioned down stream of the first set of first and second driven belts along the feed path and forming a gap along the feed path between the first set of first and second driven belts and the second set of first and second driven belts, each driven belt in the second set of driven belts positioned parallel to the feed path and facing the other driven belt forming an alley along the feed path;
and

 a sanitization apparatus positioned along the feed path in the area of the gap along the feed path between the first set of driven belts and the second set of driven belts.

9. The system as claimed in claim 8 wherein the sanitization apparatus comprises at least one apparatus for the group consisting of: an irradiation apparatus, an ultraviolet light source, a microwave emitter, an ozone generator and a chemical mister.

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10. The system as claimed in claim 8 wherein at least a portion of the feed path comprises a transport belt which travels along an edge of the first set of first and second driven belts and the second set of first and second driven belts.

11. The system as claimed in claim 10 further comprising: a sanitization area, the sanitization area containing the component for singulating and feeding a mailpiece and the sanitizer module.

12. The system as claimed in claim 11 further comprising: a clean area, the clean area for containing the output module, the clean area connected to the sanitization area at a sanitization zone, the sanitization area having an area pressure lesser than an air pressure in the clean area whereby air flow is from the clean area to the sanitization area.

13. A system for sorting and sanitizing incoming mailpieces comprising: a component for singulating and feeding a mailpiece along a feed path of the system;

a sanitizer module positioned downstream of the component for singulating and feeding the mailpiece, the sanitizer for decontaminating the mailpiece, the sanitizer module comprises:

a first set of guide walls, each guide wall in the first set of guide walls positioned parallel to the feed path and facing the other guide wall forming an alley along the feed path;

a second set of guide walls positioned downstream of the first set of guide walls along the feed path and forming a gap along the feed path between the first set of guide walls and the second set of guide walls, each guide wall in the second set of guide walls positioned parallel to the feed path and facing the other guide wall forming an alley along the feed path;

a sanitization apparatus positioned along the feed path in the area of the gap along the feed path between the first set of guide walls and the second set of guide

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walls, the sanitization apparatus comprises at least one apparatus for the group consisting of: an irradiation apparatus, an ultraviolet light source, a microwave emitter, an ozone generator and a chemical mister;

an output bin module for receiving a mailpiece after the mailpiece has been sanitized

wherein at least a portion of the feed path comprises a transport belt which travels along an edge of the first set guide walls and an edge of the second set of guide walls; and

whereby the mailpiece is sanitized as it passes by the gap along the feed path between the first set of guide walls and the second set of guide walls, and wherein

the sanitizer module is adjacent to a filtered transition area.

14. The system as claimed in claim 13 further comprising:

a sanitization area, the sanitization area containing the component for singulating and feeding a mailpiece and the sanitizer module.

15. The system as claimed in claim 14 further comprising:

a clean area, the clean area for containing the output module, the clean area connected to the sanitization area at a sanitization zone, the sanitization area having an area pressure lesser than an air pressure in the clean area.

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Appendix IX – Evidence Appendix

None

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Appendix X – Related Proceedings Appendix

While not styled a decision, the June 10, 2005 BPAI Remand in related application 10/036,982 is attached.

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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM E. RYAN, JR., ROBERT K. GOTTLIEB and JOSEPH D. MALLOZZI

Appeal No. 2005-0729
Application No. 10/036,982

Before FRANKFORT, MCQUADE and BAHR, Administrative Patent Judges.

BAHR, Administrative Patent Judge.

REMAND TO THE EXAMINER

This application is remanded to the examiner, pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)), for appropriate action with regard to the following issues.

(1) The effective filing date of the published Call application

In the final rejection (mailed November 6, 2003), the examiner rejected claims 1-11 under 35 U.S.C. § 103 as being unpatentable over Lopez et al. (hereinafter Lopez)¹

¹ U.S. Patent Application Publication No. 2003/0058099, published March 27, 2003, of Application No. 10/134,941, filed April 30, 2002, which is a continuation of Application No. 09/999,462, filed October 31, 2001.

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in view of Call et al. (hereinafter Call)² and, in the alternative, as being unpatentable over Lopez in view of Call, and further in view of Lohmann³ and/or Hayduchok et al. (hereinafter Hayduchok)⁴. Our review of the present application file indicates that the examiner did not cite the Provisional Application No. 60/337,674, on which the published Call application is purportedly based, and on the filing date of which the examiner relies in applying Call as prior art against the claims of the present application (answer, page 6), on a PTO-892 form or supply a copy thereof to the appellants. Moreover, the examiner failed to offer any explanation as to why the disclosure in the published Call application relied upon by the examiner was entitled to the benefit of the filing date of the provisional application.

The appellants argued on page 5 of their brief (filed May 5, 2004) that, in failing to provide a copy of Provisional Application No. 60/337,674 to support entitlement to the earlier filing date for the material in Call cited in the rejection, the examiner had failed to establish that Call is available as prior art against the appellants' claims. In response to that argument, the examiner simply stated, on page 6 of the answer (mailed August 30, 2004), that "Call is entitled to the benefit of the filing date of prior copending U.S. provisional patent application 60/337,674, filed on Nov. 13, 2001, and

² U.S. Patent Application Publication No. 2002/0124664, published September 12, 2002, of Application No. 10/066,404, filed February 1, 2002. This published application is based on prior U.S. Provisional Patent Application No. 60/337,674, filed November 13, 2001.

³ U.S. Pat. No. 6,169,936, issued January 2, 2001.

⁴ U.S. Pat. No. 6,303,889, issued October 16, 2001.

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therefore qualifies as a reference.⁵ The appellants again complained, on page 3 of their reply brief (filed September 3, 2004), that the examiner did not provide a copy of the provisional application to establish such entitlement and maintain their argument that "the current record does not support the use of Call '664 as a reference in the present case."

The examiner bears the initial burden of presenting a *prima facie* case of obviousness. See Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). It is thus the examiner's burden, in presenting a *prima facie* case of obviousness, to establish that Call is available as prior art under 35 U.S.C. § 102(e)⁶ with respect to the claims under appeal. This the examiner has not done.

At the very least, in order to establish that Call is available as prior art with respect to the claims under appeal, the examiner must provide the appellants with a copy of the provisional application on which it is based and point out where the disclosure relied upon in the rejection is supported in the earlier provisional application. We therefore remand this application to the examiner to review the disclosure of the provisional application to determine whether the disclosure in Call relied upon in the

⁵ The examiner's failure to provide the appellants with a copy of the provisional application at issue does not appear to have been in compliance with the USPTO policy then in effect, as set forth in the December 10, 2003 and October 29, 2004 memoranda issued to the Patent Examining Corps by Stephen G. Kunin, then Deputy Commissioner for Patent Examination Policy, directed to "transitional practice of supplying a copy of a provisional application relied upon to give prior art effect under 35 U.S.C. § 102(e) to a reference applied in a rejection."

⁶ 35 U.S.C. § 102(e) provides an exception, where the invention was described in an application for patent, published under section 122(b), by another filed in the United States before the invention thereof by the applicant for patent, to the general rule that a person is entitled to a patent.

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rejection is supported therein and, if the examiner determines that such disclosure is supported in the provisional application, (1) provide the appellants with a copy of the provisional application and (2) point out, on the record, where the material in Call relied upon in rejecting the claims under appeal is found in the provisional application.

(2) The appellants' disclosure of "a filtered transition area"

One of the argued distinctions between claim 1 under appeal and the applied prior art is the limitation "a filtered transition area downstream of the diverter." As such, it would not be prudent for us to decide this case without knowing what the appellants mean by this terminology. This filtered transition area is not illustrated in detail in any of the drawings of the present application. Rather, it is simply identified with the reference numeral 43 and an arrow in Figures 5a, 6, 7a, 8a and 9a. In Figures 5a, 6, 8a and 9a, the arrow indicates that the transition area 43 is located on the detection and/or sanitization area side of the dotted line partition between the detection and/or sanitization area and clean room while, in Figure 7a, the arrow points to the clean room side of the dotted line partition. On pages 12, 16 and 19 of the present specification, the appellants describe this transition area as follows:

Appropriate filtration and sealing can be provided in transition area 43 of the feed path F that is a passage between the clean room 42 and detection room 41 [sanitization area 40]. A containment module (not shown), for example, can be placed around that area with filtration devices and an opening along the feed path F to accommodate the largest mailpiece which can be sorted by the system.

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While this disclosure makes reference to "filtration" and "sealing," no filtration or sealing is illustrated in the drawings so as to permit us to understand what area of the disclosed system is filtered or sealed or where such filters or seals are located. Consequently, we have difficulty understanding what the appellants' disclosed "filtered transition area" is. We therefore remand this application to the examiner to consider whether the appellants' specification provides enabling disclosure of the "filtered transition area" in compliance with the first paragraph of 35 U.S.C. § 112 and to explain how this terminology in claim 1 is being interpreted.

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This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

REMANDED

Charles E. Frankfort
CHARLES E. FRANKFORT

Administrative Patent Judge

John P. McQuade
JOHN P. MCQUADE

Administrative Patent Judge

Jennifer D. Bahr
JENNIFER D. BAHR

Administrative Patent Judge

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